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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,581	10/09/2001	Jay S. Walker	01-033	5776

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STAMFORD, CT 06905

EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,581

Applicant(s)

WALKER ET AL.

Examiner

Olisa Anwah

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-22 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

INTRODUCTION

1. In view of the Appellant's Brief filed on 11/21/2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Priority

2. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must

Art Unit: 2645

be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/657,338, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The disclosure of the prior-filed application teaches the available entertainment options permit the caller (i) to place a free or subsidized call to a third party while on hold; or (ii) to access premium entertainment services while on hold (see column 3 from U.S. Patent No. 6,301,354). However, the nowhere does the disclosure of the prior-filed application mention the claimed merchants as claimed in the present application. For this reason, Applicant is not entitled to the earlier filing date of Application No. 09/657,338.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 2645

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Flockhart et al, U.S. Patent No. 6,820,260 (hereinafter Flockhart).

Regarding claim 1, Flockhart discloses a method comprising:
receiving a call from a caller, the call being associated with a first merchant (see step 200 from Figure 2);
placing the call in a queue for the first merchant (see step 202 from Figure 2);
determining a second merchant (see applet 96); and
establishing a connection (see step 210 from Figure 2), the connection enabling the caller to make a purchase (see lines 10-15 from column 5) from the second merchant while the call remains in the queue for the first merchant (see step 222 from Figure 2).

Note: the operator of the sales information, product descriptions or order forms provided in applet 96 is

Art Unit: 2645

functionally equivalent to the claimed merchant. As per the claimed connection, the process of downloading the applet reads on the claimed connection.

Regarding claim 2, Flockhart discloses a method comprising:
receiving an incoming call from a caller (see step 200 from Figure 2);

placing the incoming call in a queue (see step 202 from Figure 2);

determining at least one merchant (see applet 96);

determining access information (see column 4, line 41) associated with the at least one merchant; and

establishing a connection (see step 210 from Figure 2) based on the access information, the connection enabling the caller to make a purchase (see lines 10-15 from column 5) from the at least one merchant while the incoming call remains in the queue (222).

Note: the operator of the sales information, product descriptions or order forms provided in applet 96 (see lines 20-25 of column 4) is functionally equivalent to the claimed merchant. As per the claimed connection, the process of downloading the applet (see column 1, lines 60-65) reads on the

Art Unit: 2645

claimed connection. With respect to the claimed access information, this mechanism is inherent in Flockhart because the client is able to select from a plurality of product descriptions (see line 22 of column 4). Hence the access information of Flockhart allows the function 103 to select a specific applet 9 (see lines 55-60 of column 3). Lastly, comparable to the claimed discount identifier and promotional code in claim 16, Flockhart discusses the latest sale offering (see line 41 from column 4).

Regarding claim 3, see step 222 from Figure 2.

Regarding claim 4, see step 204 from Figure 2.

Regarding claim 5, see step 206 from Figure 2.

Regarding claim 7, see step 208 from Figure 2.

Regarding claim 8, see step 208 from Figure 2.

Regarding claim 9, see column 4, line 32.

Regarding claim 10, see column 4, line 32.

Regarding claim 11, see applets 96 and 98.

Regarding claim 12, see applets 96 and 98.

Regarding claim 13, see applets 96 and 98.

Regarding claim 14, see applets 96 and 98.

Regarding claim 15, see lines 30-35 of column 4.

Regarding claim 16, see column 4, line 41.

Art Unit: 2645

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C § 103(a) as being unpatentable over Sonesh et al, U.S. Patent No. 6,614,783 (hereinafter Sonesh) in view of Flockhart.

Regarding claim 1, Sonesh discloses a method comprising:
receiving a call from a caller, the call being associated with a first merchant (see step 601 from Figure 6);
placing the call in a queue for the first merchant (see step 630 from Figure 6);
determining a destination (see step 655 from Figure 6); and
establishing a connection with the destination while the call remains in the queue for the first merchant (see step 655 from Figure 6).

Art Unit: 2645

With further respect to claim 1, Sonesh mentions that while holding, the caller can browse through information and screens available to him at the call center WWW site or the global Internet (see lines 1-5 of column 11). Nonetheless, Sonesh fails to teach the destination is a second merchant and enabling the caller to make a purchase from the second merchant. In the same endeavor as Sonesh, Flockhart discloses a multimedia telecommunication automatic call distribution center that allows access to the call center via a plurality of access means, including telephone and data networks (compare Sonesh's abstract with Figure 1 of Flockhart). Additionally, Flockhart discloses the destination is a second merchant and enabling the caller to make a purchase from the second merchant. (see 96, 98 and column 5, lines 10-15). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sonesh's multimedia telecommunication automatic call distribution system with the applets of Flockhart. This modification would have enhanced the user friendliness of Sonesh by providing an alternative to the conventional "music-on-hold" as suggested by Flockhart (see lines 20-40 from column 1).

Citation of Pertinent Prior Art

7. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

Allowable Subject Matter

8. Flockhart shows establishing a second connection (see the applets from column 4) between the caller and the merchant. However Flockhart fails to show determining a telephone number associated with the merchant, wherein the second connection is based on the telephone number. Just like Flockhart, Sonesh clearly teaches establishing a second connection (see step 655 from Figure 6). Nonetheless, nowhere does Sonesh mention determining a telephone number associated with the merchant, wherein the second connection is based on the telephone number. For this reason, claim 17 is allowed.

Citation of Pertinent Prior Art

9. Agraharam et al, U.S. Patent No. 6,208,729 (hereinafter Agraharam) is considered pertinent to Applicant's disclosure. Similar to Applicant's invention, Agraharam permits the caller (i) to place a call to a third party while on hold; or (ii) to access premium entertainment services while on hold (see Figure 7).

Art Unit: 2645

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O.A.

Olisa Anwah
Patent Examiner
February 16, 2006


FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600